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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,825	03/22/2004	Kishio Yokouchi	073338.0494	1490
5073	7590	01/02/2009	EXAMINER	
BAKER BOTTS LLP, 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			SONG, SARAH U	
			ART UNIT	PAPER NUMBER
			2874	
		NOTIFICATION DATE	DELIVERY MODE	
		01/02/2009	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[ptomail1@bakerbotts.com](mailto:ptomail1@bakerbotts.com)  
[glenda.orrantia@bakerbotts.com](mailto:glenda.orrantia@bakerbotts.com)

<b>Office Action Summary</b>	<b>Application No.</b> 10/805,825	<b>Applicant(s)</b> YOKOUCHI, KISHIO
	<b>Examiner</b> Sarah Song	<b>Art Unit</b> 2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 August 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,5,8-12,33-36 and 39-43 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,5,8-12,33,34,36 and 39-43 is/are rejected.

7) Claim(s) 3 and 35 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 22 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) *Notice of Draftsperson's Patent Drawing Review (PTO-544)*

3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's communication filed on August 7, 2008 has been carefully considered and placed of record in the file. Claims 1-3 and 33-35 are amended. Claims 6, 7, 37 and 38 are canceled. Claims 1-3, 5, 8-12, 33-36 and 39-43 are pending.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 2, 5, 8-12, 33, 34, 36 and 39-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Glebov et al. (U.S. Patent 7,092,603 previously relied upon).**

4. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

5. Regarding claims 1 and 33, Glebov et al. discloses an apparatus for transmitting light (Figure 2) comprising: a first substrate/optical circuit board (101) having a first surface (111) including at least one optically active area (113); a second substrate (103) having a second

surface (201) positioned in opposing spaced apart relationship from the first surface (111; see column 6, lines 10-17 and 40-56); wherein the second surface contains at least one second optically active area (213) opposing the at least one first optically active area (113); where the second substrate (103) is supported substantially by the first substrate (101); a polymer layer (200; layer alternatively comprises both bridge 200 and underfill 407; see column 7, lines 60-62 and Figures 4A and 7C) disposed between the first and second substrate; a waveguide disposed within the polymer layer (the polymer material layer forms the waveguide) between the first and second optically active areas on the first and second surfaces; wherein the waveguide comprises a polymer core and a cladding for transmitting light therebetween (the core is polymer and the cladding may be air or a lower index refractive material; see column 7, lines 5-9); and one or more additional structures (211) embedded within said polymeric material.

6. Regarding claims 2 and 34, the cladding may comprise a second polymer, and the first polymer is a photosensitive polymer (i.e. UV-curable polymer; see column 7, lines 5-9 and paragraph spanning columns 8 and 9).

7. Regarding claims 5 and 36, each of the first and second substrates comprise a plurality of optically active areas (see Figure 2).

8. Regarding claims 8 and 39, the first and second surfaces are substantially parallel and spaced apart by a distance which is in the range of about 0.02 mm to about 0.15 mm (see paragraph spanning columns 9 and 10).

9. Regarding claims 9 and 40, the second substrate (103) is an IC (OEIC; column 5, line 22).

10. Regarding claims 10 and 41, the second substrate may also be a waveguide daughter board (see column 5, lines 6-9).

11. Regarding claims 11, 12, 42 and 43, one of said optically active areas comprises a photodiode or a semiconductor laser (column 5, lines 6).

***Allowable Subject Matter***

12. Claims 3 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: Glebov et al. does not disclose wherein the polymer core comprises a fluorinated polymer. Glebov et al. additionally does not qualify as prior art under 35 USC 103(c). Furthermore, Yoshimura et al. does not disclose or reasonably suggest one or more additional structures embedded within said polymer layer disposed between said first and second substrates. Therefore, claims 3 and 35 are allowable over the prior art of record.

***Response to Arguments***

14. Applicant's arguments filed August 7, 2008 have been fully considered but they are not persuasive. Applicant states that the pads 211 of Glebov are not embedded in any polymer material. Examiner respectfully disagrees. Applicants believe that the previous Office Action was claiming that the pads are embedded in optical bridge 200. However, the previous Office Action clearly indicate the polymeric material to comprise both bridge 200 and surrounding underfill 407, within which structures 211 are embedded (see ¶8-9 of previous Office Action). Claim 1 has been amended to recite that one or more additional structures are embedded within

said polymer layer. Accordingly, the rejection above indicates the polymer layer to comprise bridge 200 and surrounding underfill 407, within which structure 211 are embedded. Therefore, the rejection of the claims is deemed proper.

*Conclusion*

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Song whose telephone number is 571-272-2359. The examiner can normally be reached on M-Th 7:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on 571-272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarah Song/  
Primary Examiner, Art Unit 2874